

REMARKS

The indication of allowable subject matter in claims 8 and 13 is noted and appreciated.

Pursuant to 37 C.F.R. § 1.97(c)(2), Applicant is submitting herewith an information disclosure statement with an English translation of German Patent Publication No. 39 39 816 A1 to Saltus-Werk. The Commissioner is hereby authorized to charge Deposit Account No. 50-1039 for the fee due under 37 C.F.R. § 1.17(p).

Claims 1, 9, 16, 18, and 20 have been amended and new claim 22 has been added. It will be seen that claim 20 has been amended to provide antecedent basis for “one of the cutting blades,” which is a formal amendment, rather than a substantive amendment. As for claim 16, the drive gear has been incorporated into independent claim 9, so it has been removed from claim 16, as it is no longer necessary. Finally, new claim 22 includes similar limitations to those seen in amended claims 1 and 9, which limitations are discussed herein.

Regarding the rejection of independent claims 1 and 20 under 35 U.S.C. 103(a) as being unpatentable over You 5,067,240 in view of Pace 5,317,282 and Hirabayashi et al. 5,987,754, it is respectfully submitted that the combination does not include all of the elements of the amended claims. The Office Action acknowledges that the combination of You and Pace does not include a worm gear, a drive gear, and a main shaft. The Office Action goes on to state that “Hirabayashi et al. teaches the use of a worm gear 5d, a drive gear (25, 31 and 32) and a main shaft (See Fig. 3) . . .” However, Hirabayashi does not include a worm gear, because gear 5d is a simple toothed gear. One skilled in the art would understand the term “worm gear” to refer to a gear that meshes with a worm to transfer rotary motion between two shafts at right angles to each other. Gear 5d does not engage a worm, but instead is rotated by a pinion 5c. Thus, the gear 5d transmits rotary motion between two parallel rotational axes, in contrast to the operation of a

worm gear. Accordingly, as the combination of You, Pace, and Hirabayashi et al. fails to disclose all of the claim elements, it is respectfully submitted that independent claims 1 and 20 as amended and all claims dependent therefrom are patentable.

In addition to the reasons described above, Hirabayashi et al. does not disclose a main shaft, much less one on which a worm gear and drive gear are mounted, as required by claim 1. Figs. 4 and 5 show that the Hirabayashi et al. system is based on a series of planetary and sun gears that define rotational axes, rather than a main shaft. Even assuming that the rotational axis shared by gear 5d and driving gear 25 can be equated to a main shaft, it is clear that driving gear 25 is not engageable with one of the cutting blades, as required by claim 1. On the contrary, the rotary blade 27 of Hirabayashi et al. is engageable with constrained gears 31 and 32, which rotate about a different axis than the driving gear 25. Therefore, claim 1 and all of the claims dependent therefrom are patentable for this additional reason.

Similar to the rejection of independent claims 1 and 20, Hirabayashi et al. was relied upon to teach a worm gear, a drive gear, and a main shaft in rejecting independent claim 9. For the same reasons described above with regard to claim 1, it is respectfully submitted that claim 9 is patentable as amended. In particular, Hirabayashi et al. fails to disclose a main shaft mounted for rotation in the housing, a worm gear mounted for rotation with the main shaft and in engagement with the worm, and a drive gear mounted for rotation with the main shaft and engageable with one of the cutting blades. Thus, independent claim 9 and all of the claims dependent therefrom are patentable over the combination of You and Hirabayashi et al. because the combination fails to include all of the claim elements.

With regard to the rejection of independent claim 18, it is respectfully submitted that the claim as amended is patentable over Hirabayashi 5,642,566. First, the Office Action states that

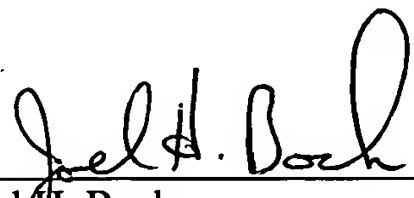
the statement in Dibbern, Jr. et al. 5,873,282 regarding the undesirability of supporting a shaft with three bearings is limited to the field of power saws. However, it will be seen that the passage at lines 58-66 of column 1 refers to "the tolerances inherent in the design of **power tools**" (emphasis added) and does not limit itself to power saws. Thus, Dibbern, Jr. et al. reflects conventional engineering knowledge, which teaches away from the use of three bearings to support a rotating shaft in any power tool, including a drill powered cable cutter. As for the statement in the Office Action that: "there is no evidence in the claim that the third bearing provides a better support than two bearing and that the third bearing is not only mere duplication," it will be seen that claim 18 has been amended to clarify that the third bearing is "for providing increased support over a shaft supported by less than three bearings along its length." Hence, it is now clear that the addition of a third bearing is not a mere duplication of parts, so reconsideration of independent claim 18 as amended is respectfully requested.

Pursuant to 37 C.F.R. § 1.97, Applicant is submitting herewith an information disclosure statement with an English translation of German Patent Publication No. 39 39 816 A1 to Saltus-Werk, which was cited in a communication from a foreign patent office regarding a related patent application. It is respectfully submitted that all of the pending claims, as amended, are patentable over the disclosure of Saltus-Werk for at least the following reasons. Independent claim 1 requires a worm gear and a drive gear mounted on a main shaft, wherein the drive gear is engageable with one of the cutting blades. Independent claim 9 requires a worm gear and a drive gear mounted for rotation with a main shaft, wherein the drive gear is engageable with one of the cutting blades. Independent claim 18 requires three bearings supporting a main shaft. Finally, independent claim 20 requires a drive gear movable with a worm gear and engageable with one of the cutting blades, wherein the cutting blades are connected to the housing at a location which

is laterally spaced from a drive shaft. It will be seen that Saltus-Werk describes a cable cutter which requires a plurality of parallel rotating shafts to operatively connect a drive shaft to a movable cutting blade. In contrast, the present application describes and claims a cable cutter with a single main shaft, which is simpler, more reliable, and less expensive than the cable cutter of Saltus-werk. Hence, Applicant respectfully submits that the pending claims as amended are structurally distinct and patentable over Saltus-Werk.

In view of all the foregoing, reconsideration and allowance of all pending claims are respectfully requested. There are now 20 total claims (4 independent) pending in the application. We have previously paid for 21 total claims (and 4 independent). Accordingly, it is believed that no additional claim fees are due. However, if any additional fees are required, the Commissioner is hereby authorized to charge Deposit Account No. 50-1039.

Respectfully submitted,

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